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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,661	01/10/2001	Thomas Magid	9726-2	7492

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,661

Applicant(s)

MAGID, THOMAS

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on March 15, 2001 is being considered by the examiner.

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. Figures 2a-2d contain improper shading, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 9-10, 12-16, 18-21, 23, 25-26, 28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,765,152 to Erickson.

Regarding claims 1, 10, and 19, Erickson discloses a computerized network, method, and a computer program product for interesting an retaining at least one qualified purchaser or licensee of intellectual property, comprising:

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- at least one seller (see at least col. 4, line 61 – col. 5, line 4; abstract);
- prospective purchaser (see at least col. 3, lines 38-43)
- a central network core site (see at least Figure 1; col. 10, lines 40-46);
 - seller presents a first level of disclosure of the intellectual property to the purchaser and request a first response, the first response comprising a fulfillment of a first demand by the purchaser (see at least col.9, lines 24-40; col. 23, lines 50-60; col. 24, lines 13-38; col. 23, lines 50-60; col. 25, lines 16-25; col. 25, lines 47-65);
 - the purchaser fulfills the first demand (see at least col. 9, lines 24-40; col. 10, line 59-col. 11, line 13; col. 24, lines 39-51);
 - the seller presents a second level of disclosure of the intellectual property of the intellectual property to the purchaser and requests a second response, the second response demand by the purchaser (see at least col. 9, lines 9-14; col. 9, lines 24-31; col. 10, line 59-col. 11, line 13; col. 24, lines 40-46; col. 25, lines 16-25);
 - the purchaser fulfills the second demand (see at least col. 9, lines 9-14; col. 9, lines 24-31; col. 10, line 59-col. 11, line 13; col. 24, lines 47-51);
and
 - the seller and the purchaser optionally enter into a contract relative to the intellectual property (see col. 9, lines 32-40; col. 11, lines 6-13; col. 24, lines 56-62).

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Regarding claims 3-7 and 12-16, Erickson discloses licensing agreement (see at least col. 14, line 66 – col. 17, line 3); an assignment of rights (see at least col. 14, line 66 – col. 17, line 3); the intellectual property is selected from the group consisting of a patent, a trademark, a copyright, a trade secret and know-how (see at least col. 2, lines 61-col. 3, line 17); each successive level of presenting has associated therewith an increasing level of security (see at least col. 17, line 65 – col. 18, line 15); and the demands comprises compensation comprising one or more money, certificate authentication, or agreements (see at least col. 20, lines 62-67; col. 24, lines 58-62).

Regarding claims 9, 18 and 20, Erickson discloses peripheral services relating to the marketing or exchange of intellectual property offered through the network (see at least col. 21, lines 13-21).

Regarding claims 21, 23, 25-26, and 28, Erickson discloses wherein the first and second responses are requested by the purchaser and comprise fulfillment of a first and second demand by the seller, and the seller fulfills the first and second demands; wherein the machine readable code enables the first and second responses to be requested by the purchaser and fulfilled by the seller; and the purchase also requests a response from the seller comprising fulfillment of a demand by the seller prior to the presentation of each level of disclosure (see at least col. 23, lines 50-60; col. 24, lines 39-51; col. 25, lines 16-25; col. 25, line 48 – col. 26, line 49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8, 11, 17, 22, 24, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,765,152 to Erickson in view of U.S. Patent No. 5,933,498 to Schneck et al.

Regarding claims 2, 8, 11, 17, 22, and 24, Erickson substantially discloses the claimed invention, however, Erickson does not explicitly disclose the seller presents additional levels of disclosure comprising requests for additional responses, the additional responses comprising fulfillment of additional demands, wherein the purchaser fulfills the demands before entering in to the contract; wherein each level of the presenting comprises revealing additional information relating to the intellectual property; wherein the purchaser requests additional responses from the seller to view additional levels of disclosure, the additional responses comprising fulfillment of additional demands by the seller, wherein the seller fulfills the demands before entering into the contract; and wherein the purchaser also requests a response from the seller comprising fulfillment of a demand by the seller prior to the presentation of each level of disclosure. Erickson discloses the minimum permissions which includes a permission data. The permission data affect the minimum use of the data within the Data Container incases where an on-line licensing transaction has not yet taken place (col. 12, lines 26-30).

Schneck, on the other hand, teaches the seller presents additional levels of disclosure comprising requests for additional responses, the additional responses

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comprising fulfillment of additional demands, wherein the purchaser fulfills the demands before entering in to the contract; wherein each level of the presenting comprises revealing additional information relating to the intellectual property; wherein the purchaser requests additional responses from the seller to view additional levels of disclosure, the additional responses comprising fulfillment of additional demands by the seller, wherein the seller fulfills the demands before entering into the contract; and wherein the purchaser also requests a response from the seller comprising fulfillment of a demand by the seller prior to the presentation of each level of disclosure (see at least col. 7, lines 1-7; col. 7, lines 41-43; col. 7, lines 50-54; col. 11, lines 50-67; col. 22, lines 55-61; col. 25, lines 41-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the computerized network, method and computer program product Erickson, to include the presenting of additional levels of disclosure comprising requests for additional responses, the additional responses comprising fulfillment of additional demands and additional information, as taught by Schneck, in order to prevent copying, restrict re-distribution of the data and provide controlled access to the data (Schneck col. 6, lines 43-46).

Regarding claims 27 and 29 (which depend on claims 2 and 11), Erickson discloses the purchase also requests a response from the seller comprising fulfillment of a demand by the seller prior to the presentation of each level of disclosure (see at least col. 23, lines 50-60; col. 24, lines 39-51; col. 25, lines 16-25; col. 25, line 48 – col. 26, line 49).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,553,143 to Ross et al. discloses a method and apparatus for the electronic management and enforcement of software licenses.

U.S. Patent No. 5,991,751 to Rivette et al. discloses a system, method and computer program product for processing data, which maintains a first database of patents, and second databases of non-patent information.

U.S. Patent No. 5,999,907 to Donner discloses an intellectual property computer-implemented audit system for valuing an intellectual property portfolio.

U.S. Patent No. 6,470,318 to Coakley discloses a computer-implemented method and system for brokering trademarks between trademark owners and potential trademark buyers.

U.S. Patent No. 6,195,646 to Grosh et al. discloses a system and method for facilitating the valuation of information and the sale of such information.

U.S. Patent No. 6,418,421 to Hurtado et al. discloses a system and related tools for the secure delivery and rights management of digital assets.

U.S. Patent No. 6,510,513 to Danieli discloses the authentication and validation of electronic data and the providing of security and enforcing restrictions on the user of electronic data.

U.S. Patent No. 6,330,547 to Martin discloses a method for establishing a value for an intangible intellectual property asset.

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U.S. Patent No. 6,556,991 to Barney discloses a method and system for rating patents and other intellectual property assets.

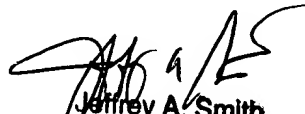
U.S. Patent No. 6,018,714 to Risen Jr. et al. discloses a method of protecting against change in value of intellectual property.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot
February 6, 2004


Jeffrey A. Smith
Primary Examiner